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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/751,436

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05/06/2005

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EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/751,436

Applicant(s)

SALIBA ET AL.

Examiner

Siegfried E. Chencinski

Art Unit

3628

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: (Please see Continuation Sheet). (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-59.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: (Please see Continuation Sheet).
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s): _____.
13. ☐ Other: _____.


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
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Continuation of 3., NOTE: Re. claims 1 and 11, the elimination of the double negative in the last limitation of these two independent claims does not change their meaning in the interpretation of these limitations. The sections of Kolling cited in the last Office Action contain numerous ways for an electronic biller to transmit a bill to a non-registered customer. Applicant's invention and Kolling's teaching both depend on the non-registered user bill recipient to have an electronic mail receiving arrangement. Applicant is referred to the full, detailed reading of the rejection references in Kolling, and the reading of the context before and after, regarding applicant's other arguments relating to the rejection of claims 1, 11 and 37.

Continuation of 11., NOTE:

Regarding claim 1, Kolling not mentioning a relationship between an email address and an amount of bill data (p. 17, ll. 15-16), Kolling's teaching throughout includes such an "in part" relationship in describing the variety of options included in Col. 5, l. 17 - Col. 6, l. 34. E-mail addresses are inherent in the options represented by the internet and personal digital assistants. Kolling inherently teaches in this and other sections that the amount of bill data will vary "in part" according to email address, including through the choices made by the intermediary regarding how much information to transmit to the consumer in the first message, as well as how much of the biller's total information will be included, since bill data includes a variety of non-essential biller and line item billing data. An examples of dependent billing data amount variations are contained in Col. 4, ll. 54-62, Col. 6, ll. 1-4.

Re. the lack of an "email server" in Kolling, any computer which sends out emails is an "email server" if it transmits electronic messages to individual addresses over the internet or an intranet. Email is an acronym for electronic mail, and the computer which sends the electronic mail into a network is performing the function of "serving" the email out, or of receiving the electronic message back in. The section referenced in the rejection explains all the hardware components used in the process. Without excluding the relevance of the rest of the reference, one representative summary sentence is contained in Col. 34, ll. 9-13 "... the CPU might receive information from the network, or might output information to the network in the course of performing the above-described steps".

Re. Applicant's argument against the rejection of claim 37 that 'Kolling does not disclose, teach or suggest a "user" or "non-user"' (p. 20, ll. 13-14), these two expressions are inherent in Kolling's teaching. Applicant's "user" and "non-user" are Kolling's two types of customers of a biller just as in Applicant's invention. In Applicant's invention, the meaning of "registered" is used in the context of whether a user is registered with the bill payment service or not. Either way, both the user and non-user have to have some method of access to an email system. In most instances, the registrant to that basic service would usually be one of the following: the user/customer, a family member, a friend or an employer. For example, the typical ISP consumer account permits several individual user names to be part of that account. Each individual name represents a unique email address. On the basis of this same concept, commercial internet accounts purchase contracts for many more addresses, such as ten, fifty, hundreds or thousands of individual addresses. The user-customer being billed electronically is registered with the bill payment system and the non-user-customer being billed electronically is not registered with the bill payment system. The remaining exposition is contained above, in the Office Action rejections, and in the prior replies to Applicant's arguments.

Re. the rejection of claim 3, Applicant argues that the rejection has failed to 'disclose "and address (underlined) of where the bill data can be confidentially viewed ..."' in Blossman. However, this limitation is taught by Kolling, and so cited in the rejection of the Office Action as being located in Kolling, Col. 19, ll. 7-13, 26-28. This is an obviousness combination rejection, with the primary reference teaching and/or suggesting this limitation. One example of Kolling's teaching of the providing of billing data over secure network connections is located in Col. 4, ll. 26-29. Kolling also teaches use of Internet links in this section, which the ordinary practitioner would have known is accomplished through URL addresses. Finally the knowledge of the ordinary practitioner of the art at the time of Applicant's invention would have been such as to know that the art provided the facility of a URL link to a secure (i.e. confidential), view of the user's bill data, motivated as noted in the Office Action's rejection.

Regarding Applicant's argument that the limitation of the "identifying a domain name from an email address" of claim 7 is not taught by Cornelius (p. 26, ll. 20-21), the ordinary practitioner of the art at the time of Applicant's invention would have recognized that this technique taught by Cornelius makes use of a standard tool available from an operating system interfacing with the Internet. It matters not what the specific application is in the Cornelius reference. The reference's purpose in this obviousness combination rejection is simply to illustrate the capability of being able to identify a domain name from an Internet address. The motivation is cited in the rejection of the last Office Action.